

second award means for issuing awards according to said second gaming event.

Claim 25 (new) - A gaming device, comprising, in combination:

a display;

a processor operatively coupled to said display, including random output means appearing on said display, resulting in a plurality of outcomes for a first gaming event;

means for playing a second gaming event concurrently with a plurality of said first gaming events; and

saving means to store the state of play on encoded moveable media, including means to dispense said encoded moveable media for use at a later time.

REMARKS

The Office Action dated May 23, 2001 has been received, its contents carefully noted, and the applied citations thoroughly studied. Accordingly, the foregoing revisions to the specification and claims are tendered with the conviction that patentable contrast has now been made manifest over the known prior art. Accordingly, all rejections tendered by the Examiner in the above-referenced Office Action are hereby respectfully traversed and reconsideration is respectfully requested.

Undersigned respectfully takes exception to the Examiner's consideration of Falciglia with Tsumura to deem the claims of record obvious. The Examiner has failed to meet the minimum burden of making a *prima facie* case for obviousness as mandated by binding compelling precedent.

It is Black Letter Law the Patent and Trademark Office's burden is to establish a *prima facie* case of non-obviousness. The Patent and Trademark Office is relieved of its burden when it fully describes: 1) What the reference discloses, teaches and suggests to one skilled in the art; 2) What the reference lacks in disclosing, teaching or suggesting vis-à-vis the claimed features; 3) What particular teaching or suggestion is being relied upon either via a reference itself or knowledge of person of ordinary skill in the art; 4) A statement explaining the proposed modification in order to establish the *prima facie* case of obviousness; and finally 5) the motivation behind the statement of obviousness which comes from three sources: a) teachings of the prior art; b) nature of the problem to be solved; or c) knowledge of persons of ordinary skill in the art, *see In re Rouffet* 47 USPQ2d 1453 (Fed. Cir. 1998).

Succinctly Falciglia has no concern whatsoever for suspending the game in progress and saving it for later use. Falciglia is quite voluminous and detailed as to a broad range of features for his game. Yet nothing in Falciglia exists in this regard as even admitted by the Examiner in the Office Action at page 2, paragraph 2.

Moreover Tsumura has nothing to do with gaming machines which accept wagers. Tsumura is merely a coin operated video game for "Role Playing" (col. 2) and nothing more.

The Examiner has failed to show any motivation in the prior art for making the proposed combination and therefore is engaging in the impermissible use of hindsight.

Undersigned provides the Examiner guidance with respect to rejections under 35 U.S.C. § 103 which is binding, compelling precedent from the Court of Appeals for the Federal Circuit.

"To reject claims in an application under Section 103, an Examiner must show an unrebutted *prima facie* case of obviousness. In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. . . . When a rejection depends on a combination of prior art references there must be some teaching, suggestion, or motivation to combine the references. . . . To prevent the use of hindsight based on the invention to defeat patentability of the invention, this Court requires the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 through 1458 (CAFC 1998) (citations omitted).

"When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." *Interconnect Planning Corp. v. Feil*, 774 F.2d at 1143, 227 U.S.P.Q. at 551. Citing *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577 & n. 14, 221 U.S.P.Q. 929, 933 & n. 14 (Fed. Cir. 1984).

"Something in the prior art as a whole must suggest the desirability and thus the obviousness of making the combination." *Lindemann Mashinenfabrick GmbH v. American Hoist and Derrick Co.*, 780 F.2d 1452, 1462, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

"It is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention." *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 437 F.2d 1044 (Fed. Cir. 1988).

Regarding the Examiner's assertion on page 3, paragraph (b) as to that which is "well known" in the art, undersigned believes that which is so well known should also be susceptible to documentation. The Examiner's use of "quasi judicial notice" fails as a *prima facie* rejection as mandated hereinabove by precedent and deprives applicant of the opportunity to analyze the alleged prior art. Further, the Examiner has failed to provide motivation for his assertion.

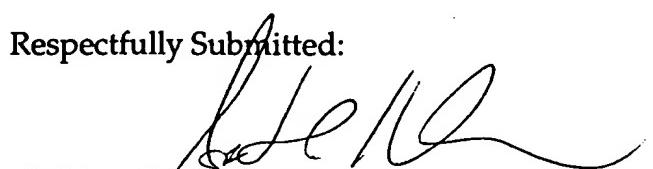
Furthermore, the claims being dismissed by the Examiner out of hand are not limited to the one feature of a subsequent gaming event.

For example, several of the claims provide for the player selecting an outcome which is to be awarded. Not only does this limitation not exist in the prior art, but Falciglia teaches away from this. For example, please see column 2, lines 23 through 27 and elsewhere. Only the machine's "determining means" in this patent can associate outcomes with an award, unlike applicant. This feature has been set apart in claims 20 and 22 for the Examiner's favorable recognition.

In view of the foregoing, it is respectfully requested that the Examiner pass this case to issue. If, upon further consideration, the Examiner believes further issues remain outstanding or new ones have been generated, undersigned respectfully requests that the Examiner call undersigned to expeditiously resolve same.

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Respectfully Submitted:



BERNHARD KRETEN
Applicant's Attorney
Telephone (916) 921-6181
Registration No.: 27,037



Bracketed and Underlined Claims under 37 C.F.R. § 1.121(c)(1)(ii)

Claim 1 (amended) - A method for gaming, the steps including:

[making a wager to enable] enabling the gaming device upon receipt of
a wager,

evoking chance means to produce a plurality of outcomes
concurrently,

displaying the plurality of outcomes,

comparing each of the plurality of outcomes to an ultimate winning
outcome,

triggering a subsequent event if any of the plurality of outcomes
matches the ultimate winning outcome,

determining whether, if none of the plurality of outcomes matches the
ultimate winning outcome, any of the plurality of outcomes matches an
intermediate winning outcome,

awarding credits if any of the plurality of outcomes matches an
intermediate winning outcome,

continuing to evoke chance means to produce subsequent pluralities of
outcomes until said ultimate winning outcome is produced or until said subsequent
outcomes are no longer possible, and

saving the current set of said outcomes and said subsequent outcomes on encoded moveable media, said encoded moveable media dispensed to the player for later use.

Claim 2 (amended) - The method of claim 1 wherein said chance means [produce] includes producing randomly-generated numbers corresponding to a randomly-numbered playfield oriented in a row-and-column (RXC) matrix in which said ultimate winning outcome consists of matching all of said randomly-generated numbers to said randomly-numbered playfield.

Claim 9 (amended) - The method of claim 7 [wherein] including configuring said subsequent gaming event [comprises means for] by simulating a racing event.

Claim 18 (amended) - The method of claim 2 [wherein] including forming said RXC matrix [is] as a three dimensional array.

More specifically, and with reference to FIG. 3, greater details with respect to the video display 2 can be explored. In the preferred embodiment, the display 2 features a plurality of randomly-numbered positions 20 in a row and column (RXC) matrix 21. Numbers for play appear in box 22 and are randomly generated by random number generator G for play on the matrix 21. Preferably, the matrix defines a 5 X 5 array, correlative of BINGO, and above row one depicts the letter "BINGO", defining, with positions 20 an alpha numeric display. The display could also be three dimensional (3D) (FIG. 4).

Thus, with BINGO, all positions 20 are initially nominated like a BINGO card. As "called" numbers appear in box 22, matches with positions 20 are highlighted.

Referring to FIG. 1, the flow chart associated with the apparatus of FIGS. 2 and 3 can be explored. In a single-player embodiment, the player engages in a gaming proposition using the display pictured of FIG. 3, on which a matrix 21 composed of randomly-numbered positions 20 is present. Randomly-generated numbers 22 appear on the display 2 and are compared to the numbers 20 on the matrix 21; if the numbers match, then that position appears bolded, highlighted or "covered" on the matrix 21. Each match (or non-match) can be a gaming proposition. The ultimate, maximum winning outcome in this embodiment is to cover all of the positions in the matrix. Before the entire matrix 21 is filled, there are opportunities to cover positions 20 in intermediate winning combinations, such as covering a certain number of positions 20 in a certain orientation, such as all in a row, all in a column,